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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,185	12/12/2003	Travis Raymond Piehl	35624-94959	2596

7590

11/23/2005

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EXAMINER

DEVORE, PETER T

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b> 10/735,185	<b>Applicant(s)</b> PIEHL ET AL.	
	<b>Examiner</b> Peter T. DeVore	<b>Art Unit</b> 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7, 8 and 27 is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 15-19, 25, 26, 28 and 29 is/are rejected.
- 7) ☒ Claim(s) 9-14, 20-24 and 30-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 18 is objected to because of the following informalities: "filed" should be "field" in line 8. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 17-19, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Gottling.

The Gottling reference discloses a proportional directional control valve comprising a source of fluid (see col. 6, last line-col. 7, first line), a first/input channel 2, a second/output channel 10, a housing having a first portion (portion which contains electronic controller/control system 43-45) and a second portion (element 1 and the housing of solenoid assembly 41), a drive pin 42, a valve assembly having a valve element 4 and a magnetic assembly 9, a magnetic positioning Hall-effect sensor/assembly 29, and a main connector 47, and whose control system operates as claimed (see col. 9, lines 1-19).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gottling in view of Harms.

The Gottling reference discloses a valve as discussed supra, but does not disclose a separable electrical coupling between the two portions of the housing. However, the Harms reference discloses a similar valve including a separable electrical coupling 188 between the two portions of the valve for ease of assembly and disassembly of the valve. It would have been obvious to employ a separable electrical coupling between the two portions of the Gottling valve in view of Harms for ease of assembly and disassembly of the valve.

Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Gottling in view of LaMarca.

The Gottling reference discloses a valve as discussed supra, but does not disclose that the electronic controller is mounted to an electronic board and surrounded by potting material. However, the LaMarca reference discloses a similar valve wherein the electronic controller is mounted to an electronic board and surrounded by potting material to protect the electronic controller (see col. 3, 3<sup>rd</sup> para.) It would have been

obvious to mount the electronic controller of the Gottling device to an electronic board and surrounded it with potting material to protect the electronic controller.

Claim 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Gottling.

The Gottling reference discloses a valve as discussed supra, but remains silent as to the material of the housing. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the housing from extruded aluminum, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *Re Leshin*, 125 USPQ 416.

#### ***Allowable Subject Matter***

Claims 7, 8, and 27 are allowed.

Claims 9-14, 20-24, and 30-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.


#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter T. deVore whose telephone number is (571) 272-4884. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pd *pd*

  
DAVID J. WALCZAK  
PRIMARY EXAMINER